

REMARKS

1. Interview Summary

The Applicants thank the Examiner for the telephone interview of November 8, 2007. The subject of the interview was a proposal for claim limitations to overcome the pending rejections. The Examiner stated that the discussed claim element, “wherein the plurality of pieces of media are in a fixed position during separation of the one of the plurality of pieces of media from the fan folded strip of media” appears to distinguish the claimed invention over the art of record, but an additional search may be required.

2. Claim Rejections – 35 U.S.C. § 103(a) – claims 23-25 and 27-30

The Examiner rejected claims 23-25 and 27-30 under 35 U.S.C. § 103(a) as being obvious over Rutherford in view of Horniak. Claims 23, 25, and 27 have been canceled thereby rendering the rejection moot with regard to claims 23, 25, and 27. The Applicants respectfully traverse the rejection. For the sake of brevity, the rejections of the independent claims 24 and 30 are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Applicants respectfully submit that Rutherford in view of Horniak fails to suggest or disclose the claimed tear bar comprising:

a rod having a first tapered portion, a second tapered portion, and a center portion positioned between the first and second tapered portion, wherein the rod has a substantially round cross section, wherein the first tapered portion has an outer diameter, wherein the second tapered portion has an outer diameter, wherein the outer diameter of the first and second tapered portions decreases towards the center portion the rod, wherein the first tapered portion, the second tapered portion, and the center portion include roughened surfaces, and wherein the first and second tapered portions concentrate stress on the bridges to facilitate a separation of one of the plurality of pieces of media from the fan folded strip of media.

Rather, Rutherford discloses a transverse burster (38, 38C-D) that is an arcuately-shaped sheet of material having a continuous surface positioned within the sheet guide 40. (See, Col. 6, lines 52-65). The Applicants submit that Rutherford's transverse burster is structurally different than the tear bar of the claimed invention. For example, the transverse burster as shown in FIGS. 4A and 14 is not a rod having first and second tapered portions and a center portion, wherein the rod has a substantially round cross section. Accordingly, the Applicants respectfully submit that the combination of Rutherford and Horniak does not disclose all the claimed limitations.

Additionally, the Applicants respectfully submit that Rutherford in view of Horniak fails to suggest or disclose that "wherein the plurality of pieces of media are in a fixed position during separation of the one of the plurality of pieces of media from the fan folded strip of media."

Rather, Rutherford discloses that the media is moving as it passes the transverse burster. Rutherford teaches that the media is required to be moving in order to provide the requisite force to separate each perforated sheet. That is, Rutherford teaches an automated process that eliminates the need for user intervention to separate pieces of media. See, Col. 7, lines 4-10. The Applicant respectfully submit that Horniak does not make up for the deficiencies of the Rutherford reference because Horniak does not teach or suggest a tear bar or other device for creating tension at a perforation separate to pieces of media. Accordingly, the Applicants respectfully submit that the combination of Rutherford and Horniak does not disclose all the claimed limitations.

Finally, the Applicants respectfully submit that Rutherford teaches away from the combination with Horniak. "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious."¹ See also M.P.E.P. § 2144.05 entitled, Rebuttal Of Prima Facie Case Of Obviousness (stating that "a prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention"). It would be improper to combine the teachings of Horniak with Rutherford. Rutherford is directed to an automated process that does not require user intervention to separate tickets. Rutherford touts in the SUMMARY OF THE INVENTION section that "this device creates a significant time savings, as office personnel are relieved of the tedious and time-consuming task of tearing off edge strips and separating the

¹ *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007).

individual items by hand." See, Col. 2, lines 11-15. In contrast, Horniak is directed to a manual system that requires a user to separate the tickets by hand. The Applicants respectfully submit that given the express teachings of Rutherford, a person of ordinary skill in the art would not look to combine the automated system of Rutherford with the manual system of Horniak.

In conclusion, the Applicants respectfully request submit that the 35 U.S.C. §103(a) rejection to claims 24 and 28-30 has been overcome and request withdrawal of the rejection.

CONCLUSION

The Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 24 and 28-30 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name Steptoe & Johnson llp.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,



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